

REMARKS

Claims 1-6, 8-25, 27-38, and 40-84 are currently pending in this Application, with claims 1, 14, 32, and 81 being in independent format. Claims 1-6, 8-25, 27-31, 45, 46, 48-65, 72-77, 79, 80, 82, and 83 have been withdrawn, and claims 7, 26, and 39 have been canceled. Claims 32-44, 47, 66-71, 78, 81, and 84 stand rejected.

In response to the final Office Action January 25, 2008, Applicants respectfully request that the Examiner amend the present application in the manner set forth in this Amendment and favorably consider the following remarks. Applicants submit that this Amendment After Final Rejection places this application in condition for allowance by amending the claims in a manner that is believed to render all pending claims allowable over the cited art, and/or at least places this application in better form for appeal. In particular, independent claims 1, 14, 32, and 81 have been amended to recite an inherent viscosity (IV) range of from 0.05 to 0.12 dL/g. This amendment was not earlier presented because Applicants believed that the prior response(s) placed this application in condition for allowance, for at least the reasons discussed in those responses. The Examiner and Applicants' representative discussed this proposed amendment via telephone on May 27, 2008. During that phone conference, the Examiner indicated that this amendment would be entered if accompanied by a convincing line of reasoning why one of ordinary skill in the art would not have been lead to the claimed IV range, based upon the teachings of the prior art. Such argument and explanation is provided in detail below. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or to reduce the number of issues for appeal, is respectfully requested under 37 C.F.R. §1.116.

In the event that the Office declines to enter the present Amendment, and (i) any portion of the present Amendment would place some of the claims in better form for appeal if a separate paper were filed containing only such amendments or (ii) any proposed amendment to any claim would render that claim allowable, Applicants respectfully request that the Office inform Applicants of the same pursuant to MPEP § 714.13.

Turning to the Action, claims 32, 37, 38, 40, 41, 43, 47, 66, 67-69, 71, 81, and 84 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,292,783 to Buchanan et al. (hereinafter “Buchanan”). Dependent claims 33-36, 39, 42, and 44 were rejected under 35 U.S.C. § 103(a) as being obvious over Buchanan. Finally, dependent claim 70 was rejected as being unpatentable over the combination of Buchanan and U.S. Patent No. 5,668,273 to Allen et al. In the Office Action, the Examiner acknowledges that the lowest IV disclosed in Buchanan is 0.20 dL/g. However, the Examiner asserts that the term “about,” recited in the claims, permits some tolerances, which makes the claimed range close enough to be anticipated by Buchanan. As mentioned above, each of the independent claims has been amended herein to recite an IV range of “from 0.05 to 0.12 dL/g.” That is, the term “about” has been removed from the claims, and the upper limit of the range has been lowered to 0.12 dL/g. Support for this amendment can be found in originally-filed claims 7, 26, and 39, which have been canceled. Applicants note that these claims were not rejected as being anticipated by Buchanan in the Action. Thus, the anticipation rejection based upon Buchanan should be overcome.

Moreover, Applicants respectfully note that even before the above-mentioned amendments, the claims were not anticipated by Buchanan. That is, a prior art reference that “teaches a value or range that is very close to, but does not overlap or touch, the claimed range *does not* anticipate the claimed range.” MPEP § 2131.03 (emphasis added). Thus, the teaching in Buchanan of an IV of 0.20 dL/g cannot anticipate the previously claimed range of from about 0.05 to about 0.15 dL/g, because these values do not overlap or touch. However, in the interest of advancing prosecution, Applicants have lowered the upper IV range to 0.12 dL/g and has removed the term “about” from this range. Accordingly, Applicants respectfully submit that Buchanan cannot anticipate the amended claims, because the lowest IV disclosed in this reference certainly cannot be said to touch or overlap the amended claimed range. See MPEP § 2131.03.

In addition, Applicants submit that the claims are also not obvious in view of Buchanan, as one of ordinary skill in the art would not be motivated to modify Buchanan

to decrease the IV to meet the claimed range of from 0.05 to 0.12 dL/g. Rather, the IV range disclosed in Buchanan is between 0.20 dL/g and 3.0 dL/g. Thus, 0.20 dL/g is the **absolute lowest** IV of those disclosed in Buchanan, and one of ordinary skill in the art would not have been motivated to decrease the IV in Buchanan below this lower limit. That is, the preferred range for the IV in Buchanan is well-above this lower limit, at 1.0-1.5 dL/g. Col. 8, ll. 22-25. Also, each of the working Examples in Buchanan uses a cellulose ester having an IV of between 1.0-1.7 dL/g, with most of the cellulose esters having an IV of between 1.2-1.3 dL/g. See e.g., Example 1 and Tables III, V, VI, IX, and XII. One of ordinary skill in the art would have understood these Examples as guiding away from lowering the IV below the lowest disclosed limit of 0.20 dL/g, because **none** of the Examples ever actually use a cellulose ester having an IV that is even remotely close to that broadly disclosed lower limit. That is, the Examples in Buchanan actually guide one of ordinary skill in the art to go higher with the IV closer to at least 1.0 dL/g.

In view of the fact that Buchanan itself does not provide any teaching or suggestion for lowering the IV below 0.20 dL/g, and only provides working examples for the range of 1.0-1.7 dL/g, motivation to modify the IV range would have to be found in the general knowledge of those of ordinary skill in the art at the time of the invention. However, Applicants submit that such motivation would not be found in the general knowledge of those skilled in the art at the time of the invention. That is, Buchanan teaches that the cellulose esters are used in blends with various polyesters to form resins used to produce molded or extruded plastic objects, fibers, and films. Buchanan teaches that films made by these blends have good tensile properties, and can be very flexible. Col. 14, ll. 36-40. Based upon the conventional thinking at the time of Buchanan, decreasing viscosity was believed to destroy these desired film properties, making the resulting films brittle and useless. This is confirmed by U.S. Patent No. 1,880,560, which is cited in Buchanan as describing exemplary cellulose esters for use in the invention of Buchanan. See col. 8, ll. 11-12. For example, the '560 patent explains that it has been known by "workers in [the] art" that cellulose acetate products with high viscosities were also un-degraded (i.e., flexible, non-brittle), and that high viscosity was viewed as a "criterion of quality." Col. 1, ll. 33-39. Thus, the goal in the

prior art was to produce cellulose acetates having higher viscosities for improved performance, because higher viscosity was seen to be a hallmark of quality cellulose esters. See col. 1, ll. 59-64. Applicants also note that the other references that were cited during prosecution of the instant application further confirm that this was the status and belief of those in the art prior to the present invention. See e.g., U.S. Patent No. 5,668,273 to Allen et al., col. 2, lines 53-62 (teaching that an increase in viscosity is desirable and improves compatibility of celluloses). Thus, Applicants respectfully submit that there is nothing in either Buchanan, or in the knowledge of those skilled in the art, generally, that would have motivated one of ordinary skill in the art to decrease the IV disclosed in Buchanan to meet the claimed range.

As a final point of distinction, Buchanan expressly teaches that cellulose esters having a lower degree of substitution (DS of around 1.7-2.75) are preferred, because they allow the incorporation of more polyester into the blend, improving the resulting product's biodegradability. Col. 14, ll. 56-65 ("lower DS cellulose ester" leads to "incorporation of more polyester in the blend [which] is highly desirable"). In contrast, the present invention is concerned with cellulose esters having a **very high** DS of 3.08-3.50. Thus, although the broad range of DS disclosed in Buchanan is 1.7 to 3.0, the preferred range is lower, at about 1.7 to 2.75. In view of these teachings, Applicants submit that one of ordinary skill in the art would not have been motivated to increase the DS in Buchanan to meet the claimed range of 3.08-3.50.

Accordingly, Applicants respectfully submit that the teachings of Buchanan are deficient with regard to the claimed invention in at least two different respects. Moreover, there is nothing in the prior art references themselves, or in the knowledge of those skilled in the art generally, that would have prompted one of ordinary skill in the art to modify the prior art compositions to meet the claim limitations. Thus, the claims are patentable over Buchanan, and the rejections based upon this reference should be withdrawn.

In view of the foregoing, Applicants submit that claims 32-44, 47, 66-71, 71, and 81, and 84 are in condition for allowance. Further, since claim 81 is generic to all

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pending claims, Applicants respectfully request rejoinder of all withdrawn claims and allowance of claims 1-6, 8-25, 27-38, and 40-84.

Respectfully submitted,

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